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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,644	06/15/2005	Uwe Hannsmann	DE920020028US1	8626
47069 7590 08/16/2007 KONRAD RAYNES & VICTOR, LLP ATTN: IBM54 315 SOUTH BEVERLY DRIVE, SUITE 210 BEVERLY HILLS, CA 90212			EXAMINER CHEMPAKASERIL, ANN J	
			ART UNIT 2166	PAPER NUMBER
			MAIL DATE 08/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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## Office Action Summary

Application No.

10/539,644

Applicant(s)

HANNSMANN ET AL.

Examiner

Ann J. Chempakaseril

Art Unit

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-11 and 16-38 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5-9, 11, 18, 22-27 and 32-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 16, 17, 19-21 and 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/15/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-3, 5-11, and 16-38 are pending

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-2, 10, 16, 17, 19-21, 28-31, drawn to synchronizing with local license related on client indicating updated license status according to client usage, classified in class 707, subclass 100.
  - II. Claims 3, 5-9, 11, 18, 22-27, 32-37, drawn to selecting content, parsing file to extract license information and downloading of content data, classified in class 707, subclass 4

The inventions are distinct, each from the other because of the following reasons:

Inventions as listed in Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination has separate utility such as follows:

Group I discloses synchronizing with generating a file comprising license information and then synchronizing with local license related data indicating updated license; while Group 2 discloses a method of receiving a file having license information and locator and downloading content data from information received from the file.

See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with David Victor on July 27, 2007 a provisional election was made with traverse to prosecute the invention of Group 1, claims 1-2, 10, 16, 17, 19-21, 28-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 5-9, 11, 18, 22-27, 32-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 10, 16, 17, 19-21, and 28-31 rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application 2003/0088516 issued to Remer et al. (hereinafter Remer).

As per claims 1, 10, and 28, Remer discloses a method for providing of content data to a client (move logic and data over networks to the end user or point- of service (POS) computer [0033]), comprising:

receiving of a selection of content data from the client (selection of licenses are requested by POS that access data [0033]) ;

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generating a file comprising license information and a locator for the content data, wherein the license information indicates a license status enabling the client to access the content data (The service agent first verifies that the digital signature of the retrieved POS license is valid (310). If so, the service agent compares the Node ID field of the current POS license with the Node ID of the existing license in the discovery database (330). If the Node IDs are different, then this must be a new POS license that has not yet been collected to the discovery database. The service agent collects a copy of the new POS license into the Servicing component's discovery database (340).

[0077]);

sending of the file to the client (sending the file with license and id to POS [0079]);

and synchronizing with local license related data on the client indicating an updated license status updated according to client usage of the content data (if there is an existing license with the same Node ID, the service agent must synchronize the retrieved POS license with the existing license on the discovery database (350). [0077])

As per claims 2, 19, and 29, Remer discloses in response to receiving the selection of the content data from the client, requesting of license conditions information from a license server (license conditions can be retrieved from servicing agent for the POS [0031]) ;

sending of information indicative of one or more license offers to the client (The current POS license, whether it be an install, trial, or previously purchased license, is

collected by the external license servicing agent to a discovery database that resides on the service management console [0035]);

and receiving an acceptance from the client (an electronic commerce site that will issue purchased licenses for the software services installed on the POS computers (240). By purchasing, the client accepts the license offers.)

As per claims 16, 20, and 30, Remer discloses the generated file comprises an XML file having a defined DTD format (The exchange of licenses may be accomplished in a number of ways. In one example implementation of the method, the exchange is accomplished by formatting an exchange license file that is in well-formed, non-validated XML described by the following DTD [0087]).


As per claims 17, 21, and 31, Remer discloses synchronizing of local license related data on the client further comprises: receiving a request to renew the license from the client and make payment for the renewal in response to the client determining that the updated license status indicates that the license has expired (refreshing. In another implementation, the licensing service agent may need to periodically collect copies of the POS licenses (either new install or trial licenses, or expired purchased licenses) from one or more POS computers and exchange them in bulk for new purchased licenses. [0021] The service agent maintains copies of collected POS licenses and new purchased licenses issued by the third party in a discovery database. The service agent synchronizes the collection of licenses from POS as well as the replacement of the POS licenses with new licenses using the discovery database. [0023])

**Contact Information**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann J. Chempakaseril whose telephone number is 571-272-9767. The examiner can normally be reached on Monday through Thursday, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Ann J Chempakaseril  
Examiner  
Art Unit 2166

August 9, 2007

  
SHAHID ALAM  
PRIMARY EXAMINER